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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,739	01/28/2005	Anthony Gerkis	213222.00099	8871

27160 7590 02/17/2009  
KATTEN MUCHIN ROSENMAN LLP  
(C/O PATENT ADMINISTRATOR)  
2900 K STREET NW, SUITE 200  
WASHINGTON, DC 20007-5118

EXAMINER
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CHRISS, ANDREW W

ART UNIT	PAPER NUMBER
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2419

MAIL DATE	DELIVERY MODE
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02/17/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/522,739	<b>Applicant(s)</b> GERKIS, ANTHONY	
	<b>Examiner</b> Andrew Chriss	<b>Art Unit</b> 2419	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 18 November 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,5,6,17,19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,5,6,17,19 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 January 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's amendment, filed November 18, 2008, has been entered and carefully considered. Claims 1, 5, 6, 17, and 19 are amended, Claims 2-4, 7-16, and 18 are amended, Claim 20 is newly added, and Claims 1, 5, 6, 17, 19, and 20 are currently pending.
2. The indicated allowability of the subject matter of canceled claims 4 and 8, as well as claims 5, 17, and 19 is withdrawn in view of the patentability issues raised under 35 U.S.C. 112, first and second paragraph, as described in the rejection below.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. **Claims 1, 5, 6, 17, 19, and 20** rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant's specification describes neither how data blocks are "implicitly sequentially numbered" nor how the "lowest data-carrying capacity that is reasonably likely to be available" would be determined. The aforementioned claim limitations are found in independent Claims 1, 6, and 20. Therefore, due to the lack of sufficient direction provided by the specification, it would require undue

Art Unit: 2419

experimentation by one skilled in the art to make and use the claimed invention. Claims 5, 17, and 19 depend on the independent claims cited above and fail to resolve the deficiencies therein.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. **Claims 1, 5, 6, 17, 19, and 20** rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Independent claims 1, 6, and 20 contain indefinite claim language that fails to define the metes and bounds of the claimed subject matter. It is unclear what is meant by "implicitly sequentially numbered blocks" in Claims 1 and 20 and "implicitly divided into sequentially numbered blocks" in Claim 6. While Applicant is entitled to act as his or her own lexicographer, Applicant must also "set out his uncommon definition in some manner within the patent disclosure" (see MPEP 2111.01). Applicant's specification does not define "implicitly" in the specification so as to inform one of ordinary skill in the art as to the uncommon meaning of said term. Further, independent claims 1, 6, and 20 cite "ideal conditions." However, the metes and bound of this phrase are not clear and are not defined in Applicant's specification. Further, independent claims 1, 6, and 20 cite the phrase "reasonably likely to be available." However, Applicant's specification does not define what is meant by this phrase. Claims 5, 17, and 19 depend on the independent claims cited above and fail to resolve the deficiencies therein. Claim 1 further cites the limitation "blocks having lengths determined so that the receiver can (i) can identify the blocks by sequence number." It is unclear based on the claim language and Applicant's specification how the length of the block relates to the receiver identifying the block by a sequence number. Further regarding Claims 19 and 20, it is

Art Unit: 2419

unclear based on the claim language and Applicant's specification what is meant by "in the same manner."

### ***Response to Arguments***

7. Applicant's arguments with respect to claims 1 and 6 have been considered but are moot in view of the new grounds of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Chriss whose telephone number is (571)272-1774. The examiner can normally be reached on Monday - Friday, 7:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hassan Kizou can be reached on 571-272-3088. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Andrew Chriss  
Examiner  
Art Unit 2419  
2/3/2009

/A. C./  
Examiner, Art Unit 2419

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